

REMARKS**A. Overview**

Claims 1-39 are pending in the present application. Claims 1, 18, 21, 32, and 36 are independent claims.

Although all the claims have been rejected, the sole grounds are obviousness based on two cited U. S. Patents. The Office Action and the cited references have been carefully reviewed. It is respectfully submitted that patentable differences exist between the claimed invention and the cited references. Reconsideration is respectfully requested.

B. Obviousness Rejection

All claims 1-39 have been rejected under 35 U.S.C. § 103. The Office Action takes the position that a combination of U. S. Patent No. 5,186,673 to Fogarty ("Fogarty ") and U. S. Patent No. 6,227,930 to Norman ("Norman") renders the claims obvious. This rejection is respectfully traversed.

A *prima facie* case of obviousness must be based on references (a) that teach, (b) a reason, suggestion or motivation to combine or modify those references, (c) in a manner which appears to show or suggest the claimed invention to one of ordinary skill in the art. A *prima facie* case of obviousness fails if either there is a lack of suggestion to combine two cited references or, even if combined, their cumulative teaching does not show or suggest the entire claimed invention to one of ordinary skill in the art. It is respectfully submitted that Fogarty and Norman fail both of these tests.

Fogarty discloses three dimensional doll clothing made up of multiple pieces. As shown in Figures 1-3, a skirt 10 as made of (a) a flexible fabric portion 12 for realistic fabric clothing appearance, (b) a resilient waistband 14 that can snap around the waist of a three dimensional

doll to hold skirt 10 in place, and (c) hook and loop strips 25 and 27 sewn or glued to opposite edges of fabric 12 to allow fabric to be closed in a skirt like fashion once snapped onto the doll waist. Other forms of clothing disclosed in Fogarty follow a similar approach, although some simply rely on a resilient piece connected to a real fabric piece to snap it onto the doll body, or simply drape relatively stiff fabric over the doll body.

Norman takes a different approach. It eschews using fabric for realism, in favor of using some type of rubber-like material to mold separate pieces of simulated doll clothing. It teaches it is impractical to use fabric for doll clothes "smaller than about eight centimeters in height, due to the difficulty experienced in forming the stitches." (Norman, col. 1, lines 7-10). As seen in Norman, the molded clothing must have openings through which the doll body can be forced and utilizes specific dimensions such that once the items are pulled onto the doll, they stay in place (e.g., doll arms go through arm openings to support dress, waist size of skirt hangs on waist of doll to support skirt, etc.). Realism is claimed because of the rubber material and decoration with "paint, varnish, glitter, etc." (Norman, col. 2, lines 20-25). Norman specifically points out that details such as "belts, buttons, and collars" are achieved by molding and painting. (Norman, col. 2, lines 26-30).

There is no suggestion to combine the teachings of Fogarty and Norman. Rather, they teach away from combination. Fogarty has chosen simulating realism of clothing by using actual fabric. Actual fabric either needs some other mechanism to hold it on the doll (e.g., its resilient snap-on piece), or simply relies on draping the fabric over parts of the doll (Fogarty, col. 2, lines 7-11). In contrast, Norman expressly rejects using fabric. It seeks simulated realism by an entirely different method -- using molded rubber that has molded details, and then uses additional

materials to ornament the rubber (e.g., paint, varnish, glitter, etc.) to try to make it look more like real fabric clothes than molded rubber.

Therefore, the teachings of Fogarty and Norman expressly take different approaches, and Norman expressly rejects or teaches away from the Fogarty approach. Therefore, a *prima facie* case of obviousness fails.

Secondly, even if solely for purposes of argument it was assumed that Fogarty and Norman could be combined, their combined teachings do not contain a reason, suggestion or motivation to combine or modify Fogarty or Norman in a manner which appear to show or suggest the claimed invention to one of ordinary skill in the art.

Each of Applicant's independent claims 1, 18, 21, 32, and 36 expressly describe a piece of material that is both elastomeric and self-adherent. As described in detail in Applicant's specification, the combination of those properties provides a number of advantages not seen to be disclosed or taught in the state of the art. Applicant's "Background of the Invention", page 1, line 9 through page 2, line 19, describes different ways the state of the art approached doll clothing. A number of two-dimensional doll clothing approaches included everything from mechanical fasteners (hooks, loops, draping, etc.), to a variety of releasable connections, including frictional, adhesive, hook and loop, electrostatic, etc. With three-dimensional dolls, however, the Applicant's specification described state of the art attempts like Fogarty and its resilient waistband, or attachment of clothing pieces by elastic features or structure allowing the clothing to be hung on or attached to the doll, both without adhesives. Applicant's specification, page 2, lines 8-12.

As seen, Fogarty uses either the resilient snap-on, separate piece from the clothing fabric to attach it to a three-dimensional doll, or just drapes the fabric over a part of the doll. It does not

meet the limitation of Applicant's claim of use of a material that is both elastomeric and self-adhering. Norman describes molded elastomeric rubber, but relies on snapping it or hanging it on the doll. It does not disclose using the elastomeric properties and self-adhering properties of the material as the method of mounting it to the doll. Thus, even if the Fogarty and Norman teachings were combined, they lack the teaching or suggestion of use of a material that has a combination of elastomeric and self-adhering properties. Thus, no *prima facie* case of obviousness is generated by a combination of Fogarty and Norman.

The Office Action correctly points out that Fogarty includes hook and loop fastener pieces on the fabric for skirt 10 of Figures 1-3. However, the function of strips 25 and 27 is simply to connect fabric panel 12 "to fully surround the rear of doll 16" so that the appearance of the skirt 10 on the doll 16 is very realistic both respect to appearance and feel." (Fogarty , col. 3, lines 7-13). This has nothing to do with supporting the clothing piece on the doll. Moreover, this requires two additional pieces, i.e., "a pair of mating two-part hook and loop strips 25 and 27," to be added to fabric panel 12. Unlike Applicant's claims, which specifically say the fabric used as the simulated doll clothing piece itself is elastomeric and self-adhering, the Fogarty hook and loop pieces must be sewn or glued or otherwise connected to the doll fabric piece simply for the purpose of making it look like a clothing item, and not to mount it on the doll. This adds to the cost, complexity, and nature of the Fogarty piece. It does not show or suggest the claimed Applicant's invention to one of ordinary skill in the art.

It is furthermore noted that the Office Action cites to U.S. Patent No. 4,197,670 to Cox ("Cox"), col. 2, lines 13-16, for the proposition that sewing, adhesive, or Velcro™ are well-known substitutes. However, like Fogarty , Cox discloses a separate hook and loop or Velcro™ fastener sewed on or glued to a fabric simulated clothing item. It is another piece or set of pieces

to add to the clothing item. It allows a different part of the doll or doll clothing to connect to the first part (e.g., for holding the doll hand in a position on the doll clothing or adding some additional feature to the doll clothing). The doll material itself does not have combined characteristics of being elastomeric and self-adhering.

It is therefore respectfully submitted that Applicant's independent claims contain a combination of limitations nowhere taught or suggested by the cited references, and that further, the cited references do not teach any combination that provides a reason, suggestion or motivation to combine themselves or modify themselves to meet Applicant's claim limitations. Fogarty wants realism by using actual fabric. Actual fabric is flexible; it is not elastomeric and self-adhering. It requires either the addition of separate pieces, such as the snap-on resilient waistband, or simply forming the fabric to drape and hang on the doll. Norman went in a different direction, rejecting fabric and relying instead on molding rubber into a clothing item shape. The flexibility and elastic nature of rubber allows the molded pieces to be stretched and snapped on or over parts of the doll to hold them in place. It does not teach or suggest a material that is both elastomeric and self-adhering.

The remaining claims are dependent from one of the independent claims and are therefore submitted to be allowable for the reasons expressed in support of the independent claims. Additionally, many of the depending claims have limitations nowhere taught or suggested by the cited references.

For example, Applicant's claim 8 describes using a second piece of said material applied onto the first piece. In essence, this allows one piece to be wrapped on a portion of the doll and a second piece to be wrapped around, laid over, laid across, or otherwise partially abutted over the first piece. The second piece can form another section of the clothing item (e.g., shoulder strap

for a shirt, lower part of pants, etc.). Alternatively, it could add ornamentation over an underlying piece (e.g., a pocket, different color panel, an appliqué, etc.). In either case, the elastomeric and self-adhering features of the second piece of material allow it to be formed and either adhered to the first piece or help it stay on the doll. It does not require additional pieces to be added to the material, such as a resilient snap on piece like Fogarty or hook and loop pieces like Fogarty. Additionally, it would not add significant thickness to the combination. For example, if hook and loop material were needed to attach the second piece to the first, the hook and loop pieces each have a thickness which would raise the second piece substantially off of the first piece. This would greatly detract from realism in the clothing item. Applicant's material can be formed to be quite thin. Even overlaying the second piece on the first can make it look like a unitary clothing item, not like two stacked pieces on top of each other.

Dependent claim 7 contemplates even a third piece overlying the second and first. For the same reasons, the nature of the material, elastomeric and self-adhering, allows this to occur, maintaining realism of a single piece of clothing without building up relatively thick layers that would detract from realism. It is important to point out that Applicant's invention actually simulates how real clothing items made of different pieces are created. For example, a skirt may have a waistband, a first top portion of one color of material, a second portion underneath of that of a separate color material, and the third lower portion terminating in the hem, of another color of material. The skirt may also have a pocket overlay on one or more of those panels of material. There might even be an appliqué or third piece of material overlaid on the pocket. As described in Fogarty, this would require intricate sewing of these various pieces with fabric to simulate the realistic piece of clothing. For smaller sized dolls, this would require separate pieces of fabric to be sewn together, which would be cumbersome and intricate to do. Norman, on the other hand,

simply says it is impractical to file the Fogarty approach. It rather simply molds the exterior contours of a simulated clothing item and then uses paint or some other material to delineate between the pieces. With Applicant's invention, the elastomeric and self-adhering material can be used to build up that article clothing on the doll without any other pieces like hook and loop fastening or glue; and without any cumbersome manufacturing steps like sewing or molding.

Applicant's specification on page 6 thru page 9 describes some examples. The user of Applicant's invention is essentially using/following the same type of pieces/instructions that one would follow if sewing a garment, being a doll size/ or adult size. The garments are formed essentially the same way. For example, the sleeve started with a narrow rectangular piece, which is then folded into a tube shape, and pressed closed at the seams. This is formed with Applicant's invention on a doll, essentially the same way it would be if the seam were sewn. By further example, then the bodice section of the top is also essentially formed the same way as if it was sewn - - with side seams or a back seam. Openings are left as arm holes, so the sleeves can be attached, again, exactly the same process if one were sewing. Layering designs on top, such as flowers, zig zags, etc. is also the same. Since the fabric in the preferred embodiment of Applicant's invention compresses when pressed, one can "squish on" many different layers without the piece becoming too bulky (unlike use of hook and loop fastener pieces in Fogarty or the molded rubber of Norman). Furthermore, with Applicant's invention, the resulting garment can be taken completely apart again into the original flat fabric pieces, and pre-formed into entirely different garments or accessories. This is an important distinction from the cited references. Fogarty must be pre-manufactured to precisely fit on the doll of a certain size and shape. Norman must be pre-molded to fit the exact size and shape doll. Applicant's claimed invention allows creation of single or multi-piece simulated clothing items with a fabric type

work on any doll of any size and shape or even on mannequins. And further, the same pieces of material that build those clothing items can be removed, and used for different clothing items on the same doll or clothing items on a separate doll, even if this next doll is of a different size.

Dependent claim 14 specifically states that different pieces Applicant's material can vary by "color, size, or shape". Again this allows the user to create different clothing items. With Fogarty and Norman, the clothing items have to be pre-made by the manufacturer.

It is therefore respectfully submitted that claims 1-39 are not obvious based on Fogarty or Norman, either alone or in combination. The Applicant has gone in a different direction of either of the cited references. It is respectfully submitted that a *prima facie* case of obviousness fails for the lack of teaching of the Applicant's claim combination by Fogarty and/or Norman and that further; there is no "clear and particular" teaching or suggestion of the desirability of modifying either Fogarty or Norman in the manner of Applicant's claims. See In re Dembiczak, 175 F.3d 994, 999 (5th Cir. 1999). The only suggestion of Applicant's claims is through hindsight gained by Applicant's claims and specification.

C. Conclusion

It is respectfully submitted that all written matter raised in the office action have been addressed and remedied and that the application is in form for allowance. Favorable action is respectfully solicited.

It is not believed that any fee for claims or petition in fee for extension of time is required for entry of this response. However, if any fee or petition for extension of time has been inadvertently overlooked, please consider this a request therefore and charge any required fee to Deposit Account No. 26-0084.

If this response does not result in the finding of allowability of the application, the undersigned respectfully requests a courtesy of a telephonic interview prior to the issuance of any further written action in the application.

Respectfully submitted,



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